

## **REMARKS**

### **I INTRODUCTION**

The above amendments to the claims of record have been made to more clearly define the claimed invention and/or to correct typographical errors. Entry of the amendment and allowance of all pending claims are respectfully requested.

Claims 30-36, 38-45, 47-54, 57-64 and 67-90 are pending and stand rejected. The following is Applicant's response to the rejections made in the Office Action (presented in the same order as addressed in the Office Action).<sup>1</sup>

### **II THE OBVIOUSNESS REJECTIONS SHOULD BE WITHDRAWN**

#### **A. CLAIMS 30-36, 39-43, 77 AND 89-90 ARE NOT OBVIOUS IN LIGHT OF THE PRIOR ART**

Claims 30-36, 39-43, 77 and 89-90 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,231,571 to D'Agostino ("D'Agostino") in view of U.S. Patent No. 4,992,940 to Dworkin ("Dworkin") and further in view of U.S. Patent No. 5,899,982 to Randle et al ("Randle"). For at least the reasons that follow, Applicant requests reconsideration and withdrawal of this rejection.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F. 2d 931, 934 (Fed. Cir. 1990); *In re Bond*, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. §2142. To establish a prima facie case of obviousness, the Examiner must show that three basic criteria are met. M.P.E.P. §2143. First, there must be some suggestion or motivation,

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<sup>1</sup> The Examiner is reminded of the co-pending application no. 09/504,374 by the same inventor of the instant application.

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when so modified or combined, must teach or suggest all of the claim limitations. *Id.* Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Finally, in discharging the initial burden of establishing a *prima facie* case, the Examiner must make particular findings as to establish the motivational element. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). That is, the PTO cannot rely on mere conclusory statements but instead must explain its reasoning why one of ordinary skill would be motivated to select the references and combine them to reach the claimed invention, and must provide evidence to support such a motivation. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Applicant respectfully submits that none of these criteria for obviousness are met here.

The Office Action fails to explain why one of ordinary skill would be motivated to select the three cited references and combine them to reach the claimed invention of Applicant. Thus, the Examiner has failed to present a *prima facie* case of unpatentability under section 103.

Indeed, the D'Agostino and Dworkin references cannot properly be combined for at least the reason that modifying D'Agostino in view of Dworkin changes the principle of operation of D'Agostino, rendering it unsuited for its intended purpose. D'Agostino requires that an operator at the representative terminal take control of the customer terminal, thereby controlling what is displayed on the customer terminal; the customer has no control over what is displayed. In contrast, Dworkin discloses a menu-driven computerized system where the customer (and *not* a representative from the central system or vendor) controls the customer display.

More specifically, D'Agostino is directed to "computer controlled method for providing personal financial services." D'Agostino, Col. 1: 7-9. D'Agostino considers the lack of human interaction to be a serious disadvantage of the prior art. Col. 2: 5-6. Thus, D'Agostino discloses a method where a customer initiates the service by dialing a representative at the financial institution allowing the institution's representative to

seize control of a desired customer terminal in response to a verbal customer request over a telephone line, thereby displaying financial service information at the customer terminal under control of the representative terminal.

D'Agostino, Col. 4: 6-14. After the representative seizes control of the of the customer terminal, "[a]ll display of information at the customer terminal is controlled by the representative and the representative terminal in response to one-to-one conversations the representative has with the customer over the telephone line." Col. 4: 14-18. The importance of allowing the customer representative to control the display on the customer's terminal is stressed throughout the D'Agostino reference, see, for example, Col. 4: 39-41; Col. 4: 43-48 and Col. 6: 53-56.

In contrast, Dworkin discloses a menu-driven computerized system whereby a customer at the remote location (and *not* a representative from the vendor) controls what is viewed at the customer's terminal. Specifically, Dworkin discloses:

In practicing the invention, the user must first tell the system the general type of product or service desired. This step can be done by selecting an appropriate item from a menu. In response to the user's choice, the system displays a template which gives various technical criteria for the product or service. By filling in one or more spaces on this template, the user can tell the system the criteria to be deemed minimum requirements.

Dworkin, Col. 2: 6-13. Similarly, Dworkin also discloses that

When the user enters the number or identifier of a product or service appearing on the above-described display, the system shows the user the names of the suppliers from whom that product or service can be obtained. The system also shows the user the prices available from each supplier. At the user's request, the system can also display a set of more detailed specifications for the chosen product or service.

Dworkin, Col. 2: 25-33. Thus, in stark contrast to D'Agostino, the customer in the Dworkin system operates the remote terminal independently of a customer representative.

Any modification of D'Agostino in view of Dworkin would be contrary to the principles of D'Agostino which require the financial institution's representative to seize control of the customer's remote computer. Such modification in view of Dworkin would also render

D'Agostino unsuited for its intended purpose because one purpose of D'Agostino is to allow the customer to "passively watch the display at the customer terminal, as if he was watching television." D'Agostino, Col. 4: 47-48. Further, any modification of D'Agostino in view of Dworkin would be contrary to D'Agostino's requirement for human interaction as the system of Dworkin is automated (see Dworkin, Col. 1: 53-55.)

For at least these reasons, Applicant respectfully submits that the D'Agostino and Dworkin references cannot properly be combined.

In response to Applicant's previous arguments, the Examiner stated that Applicant's arguments were unpersuasive since Dworkin allegedly "discloses means for a customer to communicate with the management of the system to register complaints, or to request help in using the system." Office Action at page 22 (internal citations omitted). Responsive to Examiner's observation, Applicant respectfully submits that even if Dworkin may provide for a customer's communication with management to register complaints or request help, Dworkin nevertheless does not provide for the customer representative to seize control of the customer's terminal, contrary to the requirement of D'Agostino. Indeed, even to the extent Dworkin permits a customer to contact management to register complaints or request help (and the only example is through use of an electronic mailbox, see Dworkin Col. 10: 9-12) this does nothing to change the basic premise of Dworkin – which is to provide an automated system in which the customer can operate the remote terminal independently of a customer representative. Thus, any attempt to modify D'Agostino with the teachings of Dworkin would have to include modifications allowing the customer to operate the remote terminal independently of a customer representative (as in Dworkin), which would therefore prevent the ability of representative to take control of the customer terminal and to control all information displayed to the customer, which is central to D'Agostino. Notwithstanding the Examiner's observations about Dworkin, it is improper to combine D'Agostino with Dworkin.<sup>2</sup>

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<sup>2</sup> During an interview of co-pending application no. 09/504,374 on January 28, 2003 with Examiner Thompson and supervising Examiner Coggins, Applicant presented the argument that it was improper to combine the D'Agostino and Dworkin references. Ms. Coggins and Mr. Thompson agreed, and withdrew any rejections based upon a combination of those two references.

Accordingly, and since the Examiner has not provided an explanation (supported by evidence) of a motivation to combine the D'Agostino and Dworkin references in light of the conflicting requirements of these references, Applicant requests reconsideration and withdrawal of all rejections based on combining D'Agostino and Dworkin.

Furthermore, Applicant respectfully submits that Randle is not prior art since the rejected claims find support in parent application 08/268,309 (hereinafter '309 application) filed June 29, 1994. Randle has a filing date of June 25, 1998 and purportedly is a continuation of U.S. Application Nos. 08/401,075 and 08/523,692 filed respectively March 8, 1995 and September 5, 1995. Therefore, Randle is not prior art against the rejected claims.<sup>3</sup>

Specifically, support in the '309 Application for each of the rejected claims is found in the following Table:<sup>4</sup>

Claim	Support in the '309 Application
30. An apparatus to market and sell goods or services over an electronic network comprising:	The specification at page 1, lines 10-17 discloses: "The present invention generally relates to . . . system and method for facilitating transactions. . . ."; the specification at page 8 lines 1-4 discloses: "The method by which the transactions are facilitated reduces the costs associated with creating, marketing, administering, and selling these products and services..."

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<sup>3</sup> Also, applicant's attorneys argued in the interview referenced in footnote 2 above that the Randle reference was not prior art as the claims pending therein found support in parent application 08/268,309 (hereinafter '309 application) filed June 29, 1994 and therefore predate the earliest possible Randle date of March 8, 1995. The examiners agreed and withdrew their rejections accordingly.

<sup>4</sup> All references to "the specification" are directed to the '309 Application. Applicant notes that the following Table provides examples of support in the '309 application and should not be construed as limiting or excluding other supporting text. Applicant further notes that this presentation in no way limits Applicant from establishing support for any of the claims in any earlier priority application.

Claim	Support in the '309 Application
a first computerized central communications facility adapted to be linked to a computerized remote facility and to a plurality of other computerized central communications facilities,	The specification at page 5, lines 8-10 discloses: "...whereas the present invention would with central storage permit each remote facility or location to communicate with an array of central facilities..."; the specification at page 6, line 31 – page 7 line 3 discloses: "For auction houses a number of the remote locations may be concurrently linked with one or more central facilities..."; the specification at page 7 lines 30-35 discloses: "The customer is to communicate with central facilities or locations comprising banks, ... or in general any location from which a customer might wish assistance; the specification at page 9 line 33 – page 10 line 7 discloses: "... upon pressing or utilizing the touch screen, keyboard or input device the customer may activate the system causing it to retrieve from a central facility a directory of goods and services available and thus permitting the customer to select another central facility from a displayed list or catalogue and establish contact with it and thus have access to numerous central facilities and a myriad of goods and services."

Claim	Support in the '309 Application
<p>each of said first or other computerized central communications facilities having information relating to goods or services stored in a database, and each of said first or other computerized central communications facilities having a processor programmed to:</p> <p>receive from a customer located at said computerized remote facility a request to at least one of search, browse and access in said database at said first or other computerized central communications facility for information of interest;</p> <p>enable said customer to at least one of search, browse and access said database for information of interest; and</p> <p>transmit said information of interest from the database at said computerized central communications facility to said computerized remote communications facility;</p>	<p>The specification at page 3 line 34 – page 4 line 3 discloses: "...unlike the preferred embodiment of the present invention where the information is centralized or stored centrally and thereafter transmitted to the customer at the remote location..."; the specification at page 16, lines 3-7, discloses: "[t]he customer may establish contact with the central facility's equipment without the assistance of a representative and merely help himself in a self-service mode where he may browse through databases of goods and services."; the specification at page 21 lines 28-30 discloses: "The customer may respond to questions regarding his medical history and based upon a search of medical history either at the central facility...."</p>
<p>wherein at least one of said first or other computerized central communications facilities is adapted to provide to said customer at said computerized remote facility a list of computerized central communications facilities permitting said customer to select and contact at least one other computerized central communications facility to request additional information relating to said goods or services.</p>	<p>The specification at page 9 line 33 – page 10 line 7 discloses: "... upon pressing or utilizing the touch screen, keyboard or input device the customer may activate the system causing it to retrieve from a central facility a directory of goods and services available and thus permitting the customer to select another central facility from a displayed list or catalogue and establish contact with it and thus have access to numerous central facilities and a myriad of goods and services."</p>

Claim	Support in the '309 Application
31. The apparatus of claim 30, wherein said computerized central communications facility is further programmed to facilitate a transaction between said computerized central communications facility and said computerized remote communications facility.	The specification at page 7 line 30 – page 8 line 1 discloses: “The customer is to communicate with central facilities or locations ... from which a customer might wish assistance in facilitating a transaction.”; the specification at page 8 lines 17-20 discloses: “...customer may use the electronic communications facilities and equipment at the remote location to contact a financial services company or some other central facility to facilitate a transaction...”
32. The apparatus of claim 30, wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods or services offered or any special offerings.	The specification at page 16 lines 24-30 discloses: “... the central facility or its representative may have occasion to initiate contact with a given remote facility. An example would be for use in a public or private location where the central system would contact the remote facility to apprise potential customers of goods and services offered.”



Claim	Support in the '309 Application
33. The apparatus of claim 30, wherein said computerized central communications facility and each of said other computerized central communications facilities are associated with competing providers of goods or services.	Referring to deficiencies of the prior art as compared with the embodiments of the invention, the specification, at page 6 lines 2-6, discloses: "Neither does Walker permit each remote facility to communicate with a variety of central facilities thus restricting the variety and competition for goods and services there offered..."; the specification at page 9 line 33 – page 10 line 7 discloses: "... upon pressing or utilizing the touch screen, keyboard or input device the customer may activate the system causing it to retrieve from a central facility a directory of goods and services available and thus permitting the customer to select another central facility from a displayed list or catalogue and establish contact with it and thus have access to numerous central facilities and a myriad of goods and services."; further, the specification at page 11 lines 20-32 discloses: "The reduction in costs associated with these products will then help create a greater variety of more competitive products for customers more likely to meet each customer's specific needs with greatly reduced overhead costs allowing the products to be much more competitive with other products and services ... The reduced capital requirements would also encourage smaller companies to compete. Many smaller companies currently concentrate on specific states or regions as they do not have the resources to develop products for many states. The result would be increased competition."

Claim	Support in the '309 Application
<p>34. The apparatus of claim 30, wherein at least one of said computerized central communications facility and said other computerized central communications facilities further includes an audio communication device for communication with said computerized remote communications facility.</p>	<p>Figure 1 schematically illustrates communication devices, namely, phone 34 and speaker phone 20, located at remote facility 12 and central facility 14, respectively, for providing live audio communications between central communications facility and the remote facility. Further, the specification at page 14, lines 23-32 discloses: "As seen in FIG. 1, this equipment includes a modem 30, a digital computer 32 or other means for processing information, instructions or data, a phone 34 or other means for voice exchange or audio transmission ..."</p>
<p>35. The apparatus of claim 30, wherein said computerized central communications facility and at least one of said other computerized central communications facilities is further adapted to provide information relating to goods or services in the form of an audio or video presentation.</p>	<p>In reference to providing information to the customer at the remote facility, the specification at page 17, lines 14-17, discloses: "It may comprise audio and visual information related to those goods and services ..."</p>
<p>36. The apparatus of claim 35, wherein said apparatus further comprises means for recording a presentation stopping point for future reference.</p>	<p>The specification at the sentence bridging pages 10 and 11 discloses: "To facilitate such a technique the remote or central location may record the stopping point of the customer's last on-line presentation so that when contact is resumed an appropriate presentation continuing point may be ascertained."</p>
<p>39. The apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to present information of interest to said customer.</p>	<p>The specification at page 10, lines 12-15 discloses: "...it may also be beneficial to download certain software from the central facility to the remote location to provide proper control and support for the customer ..."; also, concerning downloading from the central communications facility, the specification at page 10, lines 25-28, discloses: "It may also be beneficial to quickly download a catalogue of desired or requested information to permit the customer to review leisurely ..."</p>

Claim	Support in the '309 Application
<p>40. The apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable the customer to communicate with said central communications facility.</p>	<p>The specification at page 10, lines 12-15 discloses: "...it may also be beneficial to download certain software from the central facility to the remote location to provide proper control and support for the customer ..."; also, at page 10 lines 17-19, the specification discloses: "This would provide for the simple updating of any needed communications or other remote located software at the remote facility and ensure that each remote location will be compliant with future standards . . . ."</p>
<p>41. The apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable said customer to conduct a transaction using the information provided by said computerized central communications facility relating to goods or services.</p>	<p>The specification at page 10, lines 12-15 discloses: "...it may also be beneficial to download certain software from the central facility to the remote location to provide proper control and support for the customer ..."; further, concerning downloading from the central communications facility, the specification at page 10, lines 25-28, discloses: "It may also be beneficial to quickly download a catalogue of desired or requested information to permit the customer to review leisurely while terminating the communication link to reduce connect charges or free utilization of the central facility's resources."</p>
<p>42. The apparatus of claim 30, wherein said processor is further programmed to provide an interactive presentation relating to goods or services.</p>	<p>The specification at page 7, lines 18-23, discloses: "A number of terminals may be grouped to form an electronic shopping store permitting the customer to obtain desired information on the products of his choice while having access to highly knowledgeable representatives ..." In addition, the paragraph bridging pages 18 and 19 discloses: "Thus, the agent residing at the central financial services company 12 has the ability to control the above-described electronic communications equipment in the presence of the customer located at the remote facility 14."</p>

Claim	Support in the '309 Application
43. The apparatus of claim 42, wherein said interactive presentation includes an audio presentation in the form of a computerized voice.	The specification at page 19 lines 21-23 discloses: "The system may also utilize voice synthesis to prompt or present options to the customer and may be used in tandem with visual prompts."
77. The apparatus of claim 30, wherein said computerized central communications facility is further programmed to provide said customer with live assistance upon request.	The specification at page 15, line 31 – page 16 line 7, discloses: "At that time the customer may automatically review established presentations to better prepare him for a session with a representative and to educate the customer on the goods and services he is about to consider or at the customer's wish he may bypass these introductory presentations and immediately direct the session or request personal assistance from a representative. As an alternative the customer may establish contact with the central facility's equipment without the assistance of a representative and merely help himself in a self-service mode ..." In addition, the paragraph bridging pages 18 and 19 discloses: "Thus, the agent residing at the central financial services company 12 has the ability to control the above-described electronic communications equipment in the presence of the customer located at the remote facility 14."
89. A first computerized central communications facility linked to a plurality of other computerized central communications facilities, said first computerized central communications facility comprising:	The specification at page 9 line 33 – page 10 line 7 discloses: "... upon pressing or utilizing the touch screen, keyboard or input device the customer may activate the system causing it to retrieve from a central facility a directory of goods and services available and thus permitting the customer to select another central facility from a displayed list or catalogue and establish contact with it and thus have access to numerous central facilities and a myriad of goods and services."

Claim	Support in the '309 Application
a database of information relating to goods or services	The specification at page 16, lines 3-7, discloses: "[t]he customer may establish contact with the central facility's equipment without the assistance of a representative and merely help himself in a self-service mode where he may browse through databases of goods and services."
a communication device for communicating with a customer at a remote facility; and	Figure 1 schematically illustrates a communication device, a modem, for providing data communication between central communications facility and the remote facility. Further, the specification at page 14, lines 23-32: "As seen in FIG. 1, this equipment includes a modem 30, a digital computer 32 or other means for processing information, instructions or data, a phone 34 or other means for voice exchange or audio transmission . . . . Only a complementary printer is not needed at the financial services facility 12 for the purpose of facilitating transactions in accordance with the present invention."
a processor programmed to: receive from said customer a request to search, browse or access said database enable said customer to at least one of search, browse or access said database for information of interest communicate said information of interest to said customer	The specification at page 3 line 34 – page 4 line 3 discloses: "...unlike the preferred embodiment of the present invention where the information is centralized or stored centrally and thereafter transmitted to the customer at the remote location..."; the specification at page 16, lines 3-7, discloses: "[t]he customer may establish contact with the central facility's equipment without the assistance of a representative and merely help himself in a self-service mode where he may browse through databases of goods and services."; the specification at page 21 lines 28-30 discloses: "The customer may respond to questions regarding his medical history and based upon a search of medical history either at the central facility...."

Claim	Support in the '309 Application
direct said customer to one of said other computerized central communications facilities that has information relating to goods or services in competition with at least one of said first computerized central communications facility or said other computerized central communications facilities.	Referring to deficiencies of the prior art as compared with the embodiments of the invention, the specification, at page 6 lines 2-6, discloses: "Neither does Walker permit each remote facility to communicate with a variety of central facilities thus restricting the variety and competition for goods and services there offered..."; the sentence bridging pages 9 and 10 discloses: "In that sense an electronic phone book may be stored at the remote facility or instead upon pressing or utilizing the touch screen, keyboard or input device the customer may activate the system causing it to retrieve from a central facility a directory of goods and services available and thus permitting the customer to select another central facility from a displayed list . . . ."; further, the specification at page 11 lines 20-32 discloses: "The reduction in costs associated with these products will then help create a greater variety of more competitive products for customers more likely to meet each customer's specific needs with greatly reduced overhead costs allowing the products to be much more competitive with other products and services ... The reduced capital requirements would also encourage smaller companies to compete. Many smaller companies currently concentrate on specific states or regions as they do not have the resources to develop products for many states. The result would be increased competition."

Claim	Support in the '309 Application
<p>90. A first computerized central communications facility linked to a plurality of other computerized central communications facilities, at least one of said other computerized central communications facilities providing information relating to goods or services in competition with said first computerized central communications facility, the said first computerized central communications facility comprising:</p>	<p>Referring to deficiencies of the prior art as compared with the embodiments of the invention, the specification, at page 6 lines 2-6, discloses: "Neither does Walker permit each remote facility to communicate with a variety of central facilities thus restricting the variety and competition for goods and services there offered..."; the specification at page 9 line 33 – page 10 line 7 discloses: "... upon pressing or utilizing the touch screen, keyboard or input device the customer may activate the system causing it to retrieve from a central facility a directory of goods and services available and thus permitting the customer to select another central facility from a displayed list or catalogue and establish contact with it and thus have access to numerous central facilities and a myriad of goods and services."; further, the specification at page 11 lines 20-32 discloses: "The reduction in costs associated with these products will then help create a greater variety of more competitive products for customers more likely to meet each customer's specific needs with greatly reduced overhead costs allowing the products to be much more competitive with other products and services ... The reduced capital requirements would also encourage smaller companies to compete. Many smaller companies currently concentrate on specific states or regions as they do not have the resources to develop products for many states. The result would be increased competition."</p>
<p>a database of information relating to goods or services</p>	<p>The specification at page 16, lines 3-7, discloses: "[t]he customer may establish contact with the central facility's equipment without the assistance of a representative and merely help himself in a self-service mode where he may browse through databases of goods and services."</p>

Claim	Support in the '309 Application
<p>a communication device for communicating with a customer at a computerized remote facility; and</p>	<p>Figure 1 schematically illustrates a communication device, a modem, for providing data communication between central communications facility and the remote facility. Further, the specification at page 14, lines 23-32: "As seen in FIG. 1, this equipment includes a modem 30, a digital computer 32 or other means for processing information, instructions or data, a phone 34 or other means for voice exchange or audio transmission . . . . Only a complementary printer is not needed at the financial services facility 12 for the purpose of facilitating transactions in accordance with the present invention."</p>
<p>a processor programmed to:</p> <p style="padding-left: 40px;">receive from said customer a request for information relating to goods or services</p> <p style="padding-left: 40px;">enable said customer to at least one of search, browse or access said database for information relating to said goods or services, and</p> <p style="padding-left: 40px;">communicate said information relating to said goods or services to said customer</p>	<p>The specification at page 3 line 34 – page 4 line 3 discloses: "...unlike the preferred embodiment of the present invention where the information is centralized or stored centrally and thereafter transmitted to the customer at the remote location..."; the specification at page 16, lines 3-7, discloses: "[t]he customer may establish contact with the central facility's equipment without the assistance of a representative and merely help himself in a self-service mode where he may browse through databases of goods and services."; the specification at page 21 lines 28-30 discloses: "The customer may respond to questions regarding his medical history and based upon a search of medical history either at the central facility...."</p>



Claim	Support in the '309 Application
wherein said customer at said computerized remote facility can access information at said first computerized central communications facility and with at said at least one other competing computerized central communications facility by using software downloaded from said first computerized central communications facility or from at least one other computerized central communications facility.	

Accordingly, since these claims all find support in the '309 application, Applicant respectfully submits that Randle is not prior art against the rejected claims. Reconsideration and withdrawal of this rejection is respectfully requested.

**B. CLAIMS 44-45, 47-54, 57-64, 67-76 and 78-88 ARE NOT OBVIOUS IN LIGHT OF THE PRIOR ART**

Claims 44-45, 47-54, 57-64, 67-76 and 78-88 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over D'Agostino in view of Dworkin.<sup>5</sup> However, Applicant respectfully submits that none of the criteria for obviousness are met here. For at least the reasons that follow, Applicant requests reconsideration and withdrawal of this rejection.

First, as discussed fully above, it is improper to combine the D'Agostino and Dworkin references. For at least this reason alone, the rejection under 35 U.S.C. §103(a) should be withdrawn.

Furthermore, the cited art fails to meet at least one element in each of the rejected claims. Independent claim 44 recites, *inter alia*, a

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<sup>5</sup> While the Office Action lists claim 88 among the group of rejected claims in paragraph 4 (page 10), claim 88 is not specifically addressed in the body of the rejection.

first central communications facility adapted to direct said customer to a second central communications facility having a database of information relating to a second set of information relating to goods or services to provide upon request

Independent claim 59 recites, *inter alia*, a method

providing a first database associated with a first provider of goods or services and containing information relating to goods or services, said first database adapted to direct the customer at a remote location to a second database associated with a second provider of goods or services and containing information relating to goods or services

Independent claim 70 recites, *inter alia*, a

central communications facility adapted to direct said customer to at least one other central communications facility providing information relating to goods or services

Independent claim 82 recites, *inter alia*, a

a plurality of central communications facilities, each of said plurality of central communications facilities associated with a different provider .... wherein at least one of said central communications facilities is adapted to provide information to enable said remote facility to select and contact another one of said central communications facilities.

Independent claim 87 recites, *inter alia*, a

central communications facility adapted to provide a set of information relating to goods or services to a customer at a computerized remote facility, said central communications facility further adapted to be accessible to said customer through information provided by at least one other central communications facility

Independent claim 88 recites, *inter alia*, a

first computerized central communications facility of a first provider linked to a second computerized central communications facility of a second provider ... said first computerized central communications facility having ... a processor programmed to... direct said customer to said second computerized central communications facility, said second computerized central

communications facility having information relating to goods or services stored in a database

In pertinent part, thus, as recited above each of these independent claims recites a first central facility or database that directs the customer to or enables the customer to select and contact a second central facility or database. Neither D'Agostino nor Dworkin disclose, teach or suggest this feature, whether considered alone or in combination. Indeed, the present Office Action at pages 11, 16-17 acknowledges that D'Agostino lacks such a feature. Furthermore, in a prior Office Action (mailed January 31, 2002) at page 11, the Examiner also acknowledged that Dworkin (as well as D'Agostino) failed to disclose this feature.

At page 11 of the present Office Action, the Examiner asserts that Dworkin discloses a first communications facility adapted to direct a customer to a second communications facility, citing Dworkin Col. 10:22-45. Applicant most respectfully disagrees with this assertion. Dworkin at Col. 10:22-45 discloses nothing about a first central communications facility that is adapted to direct a customer to a second central communications facility. Rather, referring to the cited portion of Dworkin, which states in pertinent part:

For example, the user can choose from a list of software applications such as accounting, communications, database management, scientific applications, games, computer languages, operating systems, and others. The specification screen displayed in block 35 would then contain criteria pertaining to software. The program would otherwise operate in the same way as described above. A similar procedure can be used for Item No. 3 of the Main Menu. In the latter case, the user would identify the field in which a consultant is desired, and would enter, in block 37, details such as level of experience and possibly a range of hourly rates. The system would then search its database and list the software consultants fulfilling the user's criteria. In the case of software consultants, there would usually be no "product" to order, but instead the user would be given a telephone number and could call the consultant directly.

(Col. 10:25-42, emphasis added.) It is clear that Dworkin is referring only to providing a telephone number for a software consultant – *who is an individual, not a computerized central facility* – so that the user can call the consultant and speak with him/her. Thus, Dworkin fails to

disclose, teach or suggest a first computerized central communications facility that is adapted to direct a customer to a second computerized central communications facility.

Indeed, D'Agostino teaches away from a system where a first central facility directs the user to a second central facility. D'Agostino considers a serious disadvantage with the prior art systems to be the lack of human interaction. See col. 2: 5-6. Thus, D'Agostino discloses a method where a customer initiates the service by dialing a representative at the financial institution allowing the institution's representative to

seize control of a desired customer terminal in response to a verbal customer request over a telephone line, thereby displaying financial service information at the customer terminal under control of the representative terminal.

Col. 4: 6-14. The importance of allowing the customer representative to control the display on the customer's terminal is stressed throughout the D'Agostino reference, see, for example, col. 4: 39-41; col. 4: 44-48 and col. 6: 53-56. Thus, as D'Agostino teaches that each representative terminal must control the customer terminal to which it may be connected, it would make no sense to modify D'Agostino to, in effect, have a first central facility direct the user to a second central facility. Such a modification would require the representative to cede control back to the customer terminal, in violation of the teachings of D'Agostino.

For at least these reasons, Applicant submits that the references, even if combined, do not disclose, teach nor suggest at least the limitations of independent claims 44, 59, 70, 82, 87 and 88 as set forth above. For at least the same reasons, those rejected claims that are dependent on independent claims 44, 59, 70, 82, 87 and 88, respectively, are likewise not obvious. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

### **C. CLAIM 38 IS NOT OBVIOUS OVER THE PRIOR ART**

Claim 38 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over D'Agostino in view of Dworkin and further in view of U.S. Patent No. 5,347,632 to Filepp

("Filepp"). However, Applicant respectfully submits that none of the criteria for obviousness are met here.<sup>6</sup>

As an initial matter, the Office Action fails to explain why one of ordinary skill would be motivated to select the three cited references and combine them to reach the claimed invention of Applicant. Thus, the Examiner has failed to present a *prima facie* case of unpatentability under section 103.

Furthermore, for the reasons discussed more fully above, the combination of D'Agostino and Dworkin is improper. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

### **III. THE DOUBLE PATENTING REJECTION SHOULD BE WITHDRAWN**

Claims 30-36, 38-45, 47-54, 57-64 and 67-90 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,055,514 in view of Dworkin and D'Agostino.

As an initial matter, the Office Action fails to explain why one of ordinary skill would be motivated to select D'Agostino and Dworkin and combine them with the '514 patent to reach the claimed invention of Applicant. However, this does not establish a *prima facie* case of obviousness-type double patenting. Rather, in order to establish grounds for a double patenting rejection, the Office must analyze all of the considerations relating to alleged obviousness under section 103. MPEP §804. This was not done.

Furthermore, with respect to the double patenting rejection the Office Action fails to present any discussion at all for any of the claims other than claim 30.

Accordingly, this rejection should be reconsidered and withdrawn.

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<sup>6</sup> Claim 38 has been amended to change its dependency from claim 37 to claim 30, and to add the subject matter from claim 37. No change in the scope of this claim results from the amendment.

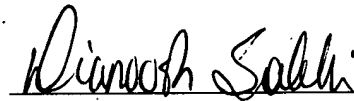
**CONCLUSION**

It is therefore respectfully submitted that claims 30-36, 38-45, 47-54, 57-64 and 67-90 are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Examiner is invited to contact the undersigned attorney if a telephonic communication is believed to be helpful in advancing the examination of the present application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 11-0600.

Respectfully submitted,



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